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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,384	11/08/2001	Gregory Wright	215760US28	5139
22850 7590 12/28/2006 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BRINICH, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/28/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/986,384

Applicant(s)

WRIGHT, GREGORY

Examiner

Stephen M. Brinich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3-7, 9-13, & 15-18 are rejected under 35

U.S.C. 102(b) as being anticipated by Hitachi Koki Imaging Solutions, Inc. "The Internet Document Controller" (October 2000).

Re claims 1, 7, & 13, The Internet Document Controller discloses (pages 3-4, "**i-manage: Remote Device Management**" and "**i-service: More Machine Uptime**") a method and apparatus for monitoring a remote image forming device in which a "remote device management" facility receives information representing an image forming device condition ("**i-service: More Machine Uptime**", page 4 - the described "remote device management" inherently require the transmission of device condition information from the device to the site where the remote diagnosis described under "**i-service: More Machine Uptime**" occurs). This device condition information includes (page 4, middle right figure indicating the display at the remote location) a first parameter indicating a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message. In order for this first parameter to serve the

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indicated function (of triggering a "maintenance warning" upon that number of pages being exceeded), a related second parameter indicating the number of pages that have been printed by the device must inherently be received and compared with the first parameter (which comparison inherently requires that the two parameters are stored for at least long enough to carry out this comparison).

Re claims 1, 3, 6-7, 9, 13, & 15, The Internet Document Controller mentions ("**i-service: More Machine Uptime**", page 4) the running of a "diagnostic" (i.e. test) procedure is run on the remote image forming device. As noted above, The Internet Document Controller describes a "remote diagnostics" operation (i.e. the test is conducted at a location remote from the image forming apparatus). The above described operation of comparing a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message and the number of pages printed by the device subsequent to such a diagnostic procedure would thus read on the claim requirement that the recited parameter is obtained after the remote image forming device is operated to execute a test operation.

Re claims 4-5, 10-11, & 16-17, The Internet Document Controller discloses ("**i-service: More Machine Uptime**", page 4) the use of e-mail to communicate between the remote image

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forming device and the remote location that receives information representing an image forming device condition.

Re claims 6, 12, & 18, The Internet Document Controller discloses ("**i-service: More Machine Uptime**", page 4) the performance of adjustments at the remote location to be transmitted to the remote image forming device resulting in a modification to the condition of the remote image forming device.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 2, 8, & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Internet Document Controller.

Re claims 2, 8, & 14, The Internet Document Controller further discloses (page 4, middle right figure) a value (corresponding to the recited "tolerance") indicating a number of pages which, when exceeded, will trigger a display of a "maintenance needed" message (as distinguished from the

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previously described "maintenance warning" message). The described "maintenance needed" message (to be triggered when the number of pages exceeds the indicated quantity) inherently requires that the second parameter (number of pages printed) and the tolerance value (number of pages that will trigger the "maintenance needed" message) are compared and stored for at least long enough to carry out this comparison.

The Internet Document Controller does not describe a highlighted display of the "maintenance needed" message.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to highlight the "maintenance needed" message.

The suggestion/motivation for doing so would have been to distinguish this message from the (less immediately in need of attention) "maintenance warning" message.

Therefore, it would have been obvious to combine a standard message highlighted display with The Internet Document Controller to obtain the invention as specified in claims 2 & 8.

***Response to Arguments***

4. Applicant's arguments filed 8/28/06 have been fully considered but they are not persuasive.

Applicant argues (8/28/06 Response: page 4, lines 3-17) that the outstanding Office Action fails to provide adequate

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rationale for the assertion that the disclosed triggering of a "maintenance warning" message at a certain number (first parameter) of pages printed inherently requires that an actual number of pages that have been printed (second parameter) be received by the disclosed remote device management arrangement and compared to the number (first parameter) that triggers the "maintenance warning" message.

However, Examiner notes that the Hitachi reference ("The Internet Document Controller") describes the use of the first parameter as "When this page count threshold is exceeded, a maintenance warning message is sent". The determination that this event ("this page count threshold is exceeded") has happened inherently constitutes a comparison between the threshold value (the first parameter) and the actual value against which the threshold is compared (the second parameter), as per the meaning of the term "threshold" as understood by one of ordinary skill in the art.

Applicant argues (8/28/06 Response: page 4, line 18 - page 5, line 10) that the Hitachi reference ("The Internet Document Controller") fails to disclose remote generation of the diagnostic (i.e. in this case, the result of the above described comparison).

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However, the described operation of the Hitachi device (e.g. "Device Control Via the Internet", "i-manage: Remote Device Management", and the "remote diagnostics" function under "i-service: More Machine Uptime") indicates that the maintenance control functions (e.g. the generation of maintenance warnings) are performed remotely.

#### **Conclusion**

5. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.



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Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.



Stephen M Brinich  
Examiner  
Technology Division 2625

smb  
December 20, 2006